REMARKS

The above-identified Office Action dated June 15, 2005, contained a final rejection of claims 1-38. Claims 1, 13, 26, and 34 have been amended in an effort to **clarify** these claims. Therefore, the Applicants submit that a new search will **not** be required by the Examiner. As such, the foregoing amendments to the claims and the remarks below are intended to place the case in condition for allowance, or alternately in better form for consideration on appeal under 37 CFR 1.116. Thus, it is respectfully requested that the amendments to claim1 be entered despite the finality of the present rejection.

The Office Action rejected claims 1-13, 15, 21-35 and 38 under 35 U.S.C. 103(a) as allegedly being unpatentable over Sakuma (U.S. Patent No. 5,663,750) in view of Motamed et al. (U.S. Patent Publication No. 2002/0060801). The Office Action also rejected claims 16-20 and 36-37 as allegedly being unpatentable over Sakuma and Motamed et al. and further in view of Kanaya et al. (U.S. Patent No. 6,517,175). Last, the Office Action rejected claim 14 as allegedly being unpatentable over Sakuma and Motamed et al. and further in view of Gormish et al. (U.S. Patent No. 5,337,362).

First, Sakuma in combination with Motamed et al. do **not** disclose all of the Applicant's elements of the currently amended claims. Specifically, **none** of cited references, in combination or alone, disclose the Applicants' "...sampling a task that uses a consumable resource to **provide a sample** by <u>overlaying a sample window over a portion</u> of the document **and** <u>providing low resolution level analysis data</u> with respect to resource requirements of the task..."

Although Motamed et al. discloses using a "...very low resolution RIP..." (see Abstract of Motamed), contrary to the Examiner's assertion on page 3, Sakuma does **not** disclose providing a sample by <u>overlaying a sample window over a portion</u> of the document. Instead, Sakuma merely discloses determining "...the total number of characters printed based on the amount of capacity consumed in the memory 22. The total amount of ink to be consumed can then be determined by multiplying the average amount of ink consumed for printing one character to the total number of characters. Alternatively, the total number of pages printed can be calculated and the average amount of ink consumed for printing each page can be multiplied to the result..." (see col. 4, lines 63-col. 5, line 2). Clearly, the character or page estimation method disclosed in Sakuma is **not** the same as the Applicants' <u>overlaying a sample window over a portion</u> of the document. In fact, nowhere in Sakuma is there a

8

disclosure of the Applicants' "overlaying" or a "sample window" features.

Next, even though the combined references do not disclose, teach or suggest all of the Applicant's features, Sakuma **cannot be** combined with Motamed et al. because Motamed teaches away from the Applicants' claimed invention. In particular, although Motamed et al. refer in paragraphs [0012 and 0027] to "...very low resolution RIP that is used specifically for the creation of thumbnail images...", Motamed et al. continue to state in paragraph [0028] it uses a "...push data flow model instead of a pull model." Motamed et al. states that "[F]or purposes of the discussion herein, a push data flow model refers to an entire print job that is pushed to a RIP by a print server, while a pull data flow model refers to pages of a print job that are pulled from the print server by the RIP." Motamed et al. uses a push model to achieve "...a reduction in concurrent bus contention on a shared bus leading into the processors. This aspect of the invention also reduces overhead on a bus leading to the processors and saves time by reducing the number of processing steps." (see paragraph [0028] of Motamed et al.).

Thus, since Motamed et al. **require** "pushing" an **entire** print job to the print server, the intended function of Motamed et al. would be destroyed if some or a few pages of a print job were pulled from the print server or if a sample window was overlayed over a portion of the document and a portion of the print job was read "...into memory directly from the print driver..." like the Applicants' claimed invention. Also, Motamed et al. would be inoperable if a sample window was overlayed over a portion of the document and a portion of the print job was read into memory first directly from the print driver because the purpose and objectives of Motamed et al. is to discover page related attributes for individual pages within a multipage job and report any potential errors or warnings with the file (see Abstract of Motamed et al.).

It is well settled that when a teaching away exists, the references **should not** and **cannot** be considered together. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Hence, this "teaching away" prevents obviousness from being established. In addition, the **failure** of the cited references, either alone or in combination, to disclose, suggest or provide motivation for the Applicant's claimed invention also indicates a lack of a prima facie case of obviousness. W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Further, these references **should not** even be considered together since the

9

Examiner used improper hindsight. It is well-settled in the law that the Examiner **cannot** use knowledge and advantages from the Applicants' disclosure nor can the Examiner arbitrarily "pick and choose" words or phrases from references and use hindsight to recreate the Applicants' invention. In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

For example, the Examiner improperly used the disclosure and the advantages described in the Applicants' invention to show obviousness when he stated on page 4 that "...providing two separate ways to predict toner consumption in a system would be preferable to only using one way..." The Examiner is reminded that there must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. **That knowledge cannot come from the applicant's invention itself.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) [emphasis added].

Additionally, the Examiner **cannot** take a single phrase out of context and assume the presence of the Applicants' invention. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1965). Namely, as argued above, the Examiner stated that Sakuma disclosed the Applicants' overlaying a sample window over a portion of the document. However, Sakuma merely discloses character or page estimation, but **never** mentions the Applicants' claimed overlaying a sample window.

Last, the Examiner is reminded that even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting.** Consequently, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [emphasis added]. Since the Examiner's rejection is based on hindsight, the rejection is improper and must be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.

Accordingly, the combined cited references cannot render the Applicants' invention obvious. This failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP

10

2143).

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

As the foregoing amendments to the claims do not raise new issues, it is the Applicant's position that they are entitled to have the changes entered to place this case in condition for allowance, or alternately, in better condition for consideration on appeal under 37 CFR 1.116. It is, therefore, respectfully requested that the changes to the claims be entered despite the finality of the present rejection.

Thus, it is respectfully requested that the claims be allowed based on the amendments and arguments. As such, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly **requests** the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to:

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Respectfully submitted,
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11